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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92059915
Party	Defendant CA IP Holdings, LLC
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Submission	Answer and Counterclaim
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Date	10/20/2014
Attachments	Cancellation 92059915 - Answer to Petition to Cancel - FINAL.pdf(166537 bytes)

Registration Subject to the filing

Registration No	3336267	Registration date	11/13/2007
Registrant	GE NUTRIENTS, INC. 19700 Fairchild Road Irvine, CA 92612 UNITED STATES		
Grounds for filing	The registered mark has been abandoned.		
	The registration was obtained fraudulently.		

Goods/Services Subject to the filing

Class 005. First Use: 2005/06/30 First Use In Commerce: 2005/06/30
All goods and services in the class are requested, namely: dietary supplements sold and distributed over the counter

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

GE Nutrients, Inc.,
Petitioner

v.

CA IP Holdings, LLC,
Registrant

Cancellation No. 92059915
Registration No. 4,302,581
Mark: TESTOGEN-XR

**REGISTRANT’S ANSWER TO PETITION FOR CANCELLATION, AFFIRMATIVE
DEFENSES, AND COUNTERCLAIMS TO CANCEL PETITIONER’S REGISTRATION
NO. 3,336,267**

CA IP Holdings, LLC. (“Registrant”), by and through undersigned counsel, hereby submits this Answer in response to the Petition for Cancellation filed in this matter by GE Nutrients, Inc. (“Petitioner”). Unless specifically admitted below, Registrant denies each and every allegation in the Petition for Cancellation. Registrant further answers the numbered paragraphs in the Petition for Cancellation as follows:

1. Registrant is without knowledge or information sufficient to form a belief as to the allegations of Paragraph 1 of the Petition for Cancellation and therefore denies those allegations.

2. Registrant is without knowledge or information sufficient to form a belief as to the allegations of Paragraph 2 of the Petition for Cancellation and therefore denies those allegations.

3. Registrant is without knowledge or information sufficient to form a belief as to the allegations of Paragraph 3 of the Petition for Cancellation and therefore denies those allegations.

4. Registrant admits the allegations of Paragraph 4 of the Petition for Cancellation.

5. With respect to the "claimed first date of use" in the first sentence of Paragraph 5 of the Petition for Cancellation, due to the ambiguity as to whether Petitioner is inquiring about first date of use anywhere or first date of use in interstate commerce, Registrant is without knowledge or information sufficient to form a belief as to the truth or falsity thereof. To the extent an answer is required, Registrant admits the allegations. With respect to the "earliest date upon which Registrant can rely for purposes of determining priority of use" in the second sentence of Paragraph 5 of the Petition for Cancellation, Registrant responds that this sentence calls for a legal conclusion, requiring no answer. To the extent an answer is required, Registrant admits the allegations.

6. Registrant is without knowledge or information sufficient to form a belief as to the allegations of Paragraph 6 of the Petition for Cancellation and therefore denies those allegations.

7. Registrant denies the allegations of Paragraph 7 of the Petition for Cancellation.

AFFIRMATIVE DEFENSES

First Affirmative Defense (Laches)

8. Registrant began using the TESTOGEN-XR mark in 2011 by promoting dietary supplements for supporting testosterone production. Registrant invested and continues to invest large amounts of time and monetary resources towards promoting and selling said dietary supplements throughout the United States in connection with the mark TESTOGEN-XR.

9. Registrant applied for registration of the mark TESTOGEN-XR on January 26, 2012.

10. The mark TESTOGEN-XR was published in the Official Gazette on June 19, 2012, giving any person who believed he/she would be damaged an opportunity to oppose the mark, prior to the mark receiving a registration.

11. Upon information and belief, Petitioner possessed knowledge (or should have known) of Registrant's trademark application and failed to oppose the mark, either before the Trademark Trial and Appeals Board (TTAB) or through any direct correspondence with Registrant.

12. Registrant received Registration No. 4,302,581 from the United States Patent and Trademark Office (USPTO) on March 12, 2013. Thereafter, Registrant continued to promote and sell dietary supplements in connection with the mark TESTOGEN-XR, investing large amounts of time and monetary resources towards promoting the mark and creating good will in its consumers.

13. Upon information and belief, Petitioner possessed knowledge (or should have known) of Registrant's use of the mark TESTOGEN-XR in connection with dietary supplements for supporting testosterone production prior to and on March 12, 2013, the date of registration of the Registrant's mark TESTOGEN-XR.

14. Petitioner waited until September 9, 2014, to file the Petition for Cancellation (Cancellation No. 92059915), approximately 18 months after Registrant received its registration. During this time, Registrant made a considerable investment creating good will in its consumers for the mark TESTOGEN-XR in connection with dietary supplements for promoting testosterone production. Petitioner's delay in taking any action prior to September 9, 2014 is inexcusable.

15. Petitioner's inexcusable delay resulted in Registrant's detrimental reliance. In reliance on Petitioner's silence and inaction, Registrant built up a valuable business and good will around the mark TESTOGEN-XR.

16. Based on the doctrine of laches, Petitioner should be barred from benefiting from Petitioner's own inexcusable delay, which resulted in detrimental reliance by the Registrant.

Second Affirmative Defense (Estoppel)

17. Registrant repeats and realleges, as if fully set forth herein, each and every allegation contained in the foregoing paragraphs.

18. Upon information and belief, Petitioner possessed knowledge (or should have known) of Registrant's trademark application for the mark TESTOGEN-XR, published in the Official Gazette on Jun 19, 2012, and failed to oppose the mark, either before the Trademark Trial and Appeals Board (TTAB) or through any direct correspondence with Registrant.

19. After Registrant received its registration from the USPTO on March 12, 2013, Registrant continued to promote and sell dietary supplements in connection with the mark TESTOGEN-XR, investing large amounts of time and monetary resources towards promoting the mark and creating good will in its consumers.

20. Upon information and belief, Petitioner possessed knowledge (or should have known) of Registrant's use of the mark TESTOGEN-XR in connection with dietary supplements for supporting testosterone production prior to and on March 12, 2013, the date of registration of the Registrant's mark TESTOGEN-XR.

21. Petitioner waited until September 9, 2014, to file the Petition for Cancellation (Cancellation No. 92059915), approximately 18 months after Registrant received its registration. During this time, Registrant made a considerable investment creating good will in its consumers for the mark TESTOGEN-XR in connection with dietary supplements for promoting testosterone. Petitioner's silence and inaction lead Registrant to reasonably infer that Petitioner would not assert any action against Registrant's use and registration of the TESTOGEN-XR mark in connection with dietary supplements for testosterone production.

22. Due to this reliance, Registrant built up a valuable business and good will around the mark TESTOGEN-XR, which would result in material prejudice to Registrant if the delayed assertion by the Petitioner is permitted.

23. Based on the doctrine of equitable estoppel, Petitioner should be estopped from benefiting from Petitioner's own unreasonable delay, which would result in material prejudice to Registrant.

24. Registrant reserves its right to amend the above affirmative defenses during the term of this proceeding and through evidence and information acquired during discovery.

COUNTERCLAIMS TO
CANCEL PETITIONER'S REGISTRATION NO. 3,336,267

BACKGROUND

25. Registrant repeats and realleges, as if fully set forth herein, each and every allegation contained in the foregoing paragraphs.

26. Registrant is engaged in a successful business, selling dietary supplements for testosterone production.

27. Registrant has invested a great deal of time and money in promoting Registrant's business, and is continuing to spend substantial amounts of time and money in the promotion of the same.

28. On January 26, 2012, Registrant applied for the registration of TESTOGEN-XR on the Principal Register for "dietary supplements for testosterone production." On March 12, 2013, Registrant received a registration from the USPTO for the same.

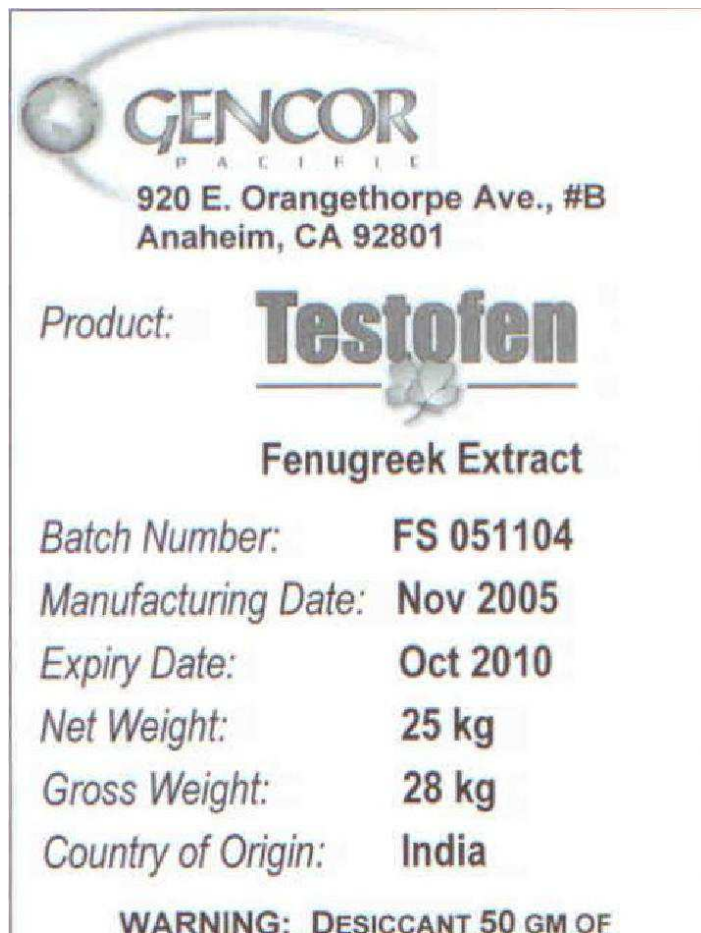
29. On June 22, 2005, Petitioner applied for registration of TESTOFEN, under 15 U.S.C. § 1051(b), on the Principal Register for "dietary supplements."

30. On June 22, 2005, Petitioner submitted a sworn declaration to the USPTO that Petitioner possessed "a bona fide intention to use the mark in commerce on or in connection with the identified goods," which identified goods were, at said date, "dietary supplements" in international class 005.

31. On June 22, 2005, Petitioner submitted a sworn declaration to the USPTO in which it was declared under oath that "willful false statements, and the like, may jeopardize the validity of the application or any resulting registration...and that all statements made of his/her own knowledge are true."

32. On January 13, 2006, the USPTO issued an Office Action in connection with Petitioner's application, requiring that Petitioner "indicate whether the wording 'TESTOFEN' has any significance in the relevant trade or industry or as applied to the goods/services."

33. In response, on July 11, 2006, Petitioner responded that the "mark TESTOFEN has no significance in the relevant trade or industry or as applied to the goods/services." Upon information and belief, Petitioner made a false representation to the USPTO, knowing that the term FEN was, in fact, significant, as descriptive of the singular ingredient in Petitioner's goods: fenugreek extract. In fact, Petitioner's specimen of use, reproduced herein below, filed with the U.S. Trademark Office on August 13, 2007, clearly demonstrates that Petitioner's goods are fenugreek extract.



34.

35. In response to the January 13, 2006 Office Action, on July 11, 2006, Petitioner responded that the "mark TESTOFEN has no significance in the relevant trade or industry or as

applied to the goods/services.” Upon information and belief, Petitioner made a false representation to the USPTO, believing that the term TESTO was, in fact, significant, as descriptive of the result of ingestion of Petitioner’s goods: an increase in testosterone.

36. On November 20, 2006, Registrant filed an amendment to the identification of the goods from “dietary supplements” to “dietary supplements SOLD AND DISTRIBUTED OVER THE COUNTER.” The term “over the counter” is well known by those in the industry to indicate products available to the general public without prescription. Upon information and belief, Petitioner made a false representation to the USPTO that the Petitioner possessed a bona fide intention to use the mark TESTOFEN in connection with dietary supplements sold and distributed “over the counter,” i.e., to the general public, when, in fact, Petitioner’s intent was to sell fenugreek extract in bulk as an ingredient to chemical compounders, who combine various ingredients into a formula, rather than over the counter. Upon information and belief, Petitioner’s use of the mark TESTOFEN, has, until very recently, been restricted to the sale of fenugreek extract as an ingredient to chemical compounders and not to the general public.

37. On August 13, 2007, Petitioner filed a Statement of Use stating that the mark TESTOFEN was first used as early as June 30, 2005 as a “dietary supplements sold and distributed over the counter.” Further, within the Statement of Use, Petitioner submitted a sworn declaration to the USPTO that Petitioner was warned that “willful false statements and the like may jeopardize the validity of” the application. Upon information and belief, Petitioner made a false statement to the USPTO, knowing that Petitioner’s use was restricted to selling fenugreek extract as an ingredient to chemical compounders, as opposed to “over the counter,” i.e., the general public.

38. On May 16, 2013, Petitioner filed a Combined Declaration of Use and Incontestability under Sections 8 & 15 declaring that “the mark is in use in commerce on or in connection with all of the goods or services listed in the existing registration for this specific class: dietary supplements sold and distributed over the counter; and the mark has been continuously used in commerce for five (5) consecutive years after the date of registration...and is still in use in commerce on or in connection with all goods or services listed in the existing registration for this class.” Upon information and belief, Petitioner made a false statement to the

USPTO, knowing that Petitioner's use was restricted to selling fenugreek extract as an ingredient to chemical compounds, rather than "over the counter," i.e., to the general public. Upon information and belief, on or before May 16, 2013, when the Section 8 & 15 declarations were filed, Petitioner had, in fact, not sold any dietary supplements over the counter using the mark TESTOFEN.

**FIRST CLAIM FOR CANCELLATION:
VOID AB INITIO**

39. Registrant repeats and realleges, as if fully set forth herein, each and every allegation contained in the foregoing paragraphs.

40. Registrant expressly alleges that Registrant's standing is based on its position as defendant in the present cancellation.

41. Upon information and belief, Petitioner's statement of use of the mark TESTOFEN in commerce for the identified goods, namely dietary supplements sold and distributed over the counter, at the time of filing of Petitioner's application was false, and therefore Registration No. 3,336,267 should be considered void ab initio, invalid from the start.

**SECOND CLAIM FOR CANCELLATION:
FRAUD IN THE PROCUREMENT OF ITS REGISTRATION**

42. Registrant repeats and realleges, as if fully set forth herein, each and every allegation contained in the foregoing paragraphs.

43. Petitioner made false representations: 1) on June 22, 2005, regarding its bona fide intent to use the mark TESTOFEN on dietary supplements; 2) on August 13, 2007, in its Statement of Use alleging use in commerce on dietary supplements sold and distributed over the counter; and 3) On May 16, 2013, in its Section 8 and 15 declarations alleging continuous use in commerce on all of the goods listed in the registration.

44. Petitioner's false representations are material to registrability, because the registration certificate falsely indicates to the public that the goods that are protected by the registration are dietary supplements sold and distributed over the counter, when in fact the

Petitioner had only been using the mark TESTOFEN on fenugreek extract, as an ingredient for sale to chemical compounders.

45. Upon information and belief, Petitioner had knowledge of the falsity of the representation because Petitioner specifically requested that the USPTO amend the identification of goods to include “OVER THE COUNTER.” Yet, upon information and belief, Petitioner knew or should have known that its use and intent to use was restricted to the sale of fenugreek extract as an ingredient to chemical compounders and not the general public.

46. Upon information and belief, Petitioner’s false representations were made in bad faith and with intent to deceive the USPTO.

47. Petitioner’s false representations have injured Registrant by, among other things, providing Petitioner standing to institute the instant Petition for Cancellation, thereby causing Petitioner the expense of responding.

48. Upon information and belief, the conduct of Petitioner constitutes fraud on the USPTO and injures Registrant and the purchasing public. Therefore, Registration No. 3,336,267 should be cancelled.

**THIRD CLAIM FOR CANCELLATION: FRAUD DURING
THE PROSECUTION OF ITS APPLICATION FOR REGISTRATION**

49. Registrant repeats and realleges, as if fully set forth herein, each and every allegation contained in the foregoing paragraphs.

50. During prosecution of its application for registration, Petitioner represented that TESTOFEN “has no significance in the relevant trade or industry or as applied to the goods/services.” Upon information and belief, said representation by Petitioner was false because Petitioner knew that FEN was descriptive of the single ingredient in Petitioner’s goods—fenugreek extract.

51. Upon information and belief, said false representation is material to registrability because the USPTO would likely have issued a rejection of Petitioner’s application as being merely descriptive of the goods.

52. Upon information and belief, Petitioner's false representation was made in bad faith and with intent to deceive the USPTO.

53. Petitioner's false representations have injured Registrant by, among other things, providing Petitioner standing to institute the instant Petition for Cancellation, thereby causing Petitioner the expense of responding.

54. Upon information and belief, the conduct of Petitioner constitutes fraud on the USPTO and injures Registrant and the purchasing public. Therefore, Registration No. 3,336,267 should be cancelled.

**FOURTH CLAIM FOR CANCELLATION: FRAUD DURING
THE PROSECUTION OF ITS APPLICATION FOR REGISTRATION**

55. Registrant repeats and realleges, as if fully set forth herein, each and every allegation contained in the foregoing paragraphs.

56. During prosecution of its application for registration, Petitioner represented that TESTOFEN "has no significance in the relevant trade or industry or as applied to the goods/services." Upon information and belief, said representation by Petitioner was false because Petitioner believed that TESTO was descriptive of the result of ingestion of Petitioner's goods—an increase in testosterone.

57. Upon information and belief, said false representation is material to registrability because the USPTO would likely have issued a rejection of Petitioner's application as being merely descriptive of the goods.

58. Upon information and belief, Petitioner's false representation was made in bad faith and with intent to deceive the USPTO.

59. Petitioner's false representations have injured Registrant by, among other things, providing Petitioner standing to institute the instant Petition for Cancellation, thereby causing Petitioner the expense of responding.

60. Upon information and belief, the conduct of Petitioner constitutes fraud on the USPTO and injures Registrant and the purchasing public. Therefore, Registration No. 3,336,267 should be cancelled.

**FIFTH CLAIM FOR CANCELLATION:
ABANDONMENT DUE TO NONUSE**

61. Registrant repeats and realleges, as if fully set forth herein, each and every allegation contained in the foregoing paragraphs.

62. Upon information and belief, Petitioner did not use the mark TESTOFEN on dietary supplements sold and distributed over the counter for at least three consecutive years since the issuance of Petitioner's registration. Therefore, Petitioner abandoned its registration due to nonuse.

**SIXTH CLAIM FOR CANCELLATION:
PARTIAL CANCELLATION UNDER THE TRADEMARK
ACT § 18, 15 U.S.C. § 1068, FOR ABANDONMENT**

63. Registrant repeats and realleges, as if fully set forth herein, each and every allegation contained in the foregoing paragraphs.

64. Upon information and belief, Petitioner did not use the mark TESTOFEN on dietary supplements sold and distributed over the counter for at least three consecutive years since the issuance of Petitioner's registration.

65. Registrant requests, in conformance with 15 U.S.C. § 1068, a partial cancellation of Registration No. 3,336,267, deleting the identification of goods with respect "dietary supplements sold and distributed over the counter" and adding the identification "fenugreek extract sold and distributed to chemical compounds," or other like identification that truthfully and accurately reflects Petitioner's original use of the corresponding goods. Said partial cancellation would avoid any alleged likelihood of consumer confusion, as the Petitioner's and Registrant's goods would be offered in different channels of trade. Additionally, Petitioner's consumers would not be likely to be confused due to their sophistication.

WHEREFORE, Registrant denies that Petitioner is entitled to any relief and requests that the Board dismiss the Petitioner's Petition for Cancellation filed in this proceeding. Registrant prays Registration No. 3,336,267 be cancelled, or alternatively, that Registration No. 3,336,267 be partially cancelled.

Dated: October 20, 2014

Respectfully submitted,

The Concept Law Group, P.A.

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Attorney for Registrant,
CA IP Holdings, LLC

Certificate of Mailing and Service

I certify that on October 20, 2014, the foregoing ANSWER TO PETITION TO CANCEL AND COUNTERCLAIM is being served by mailing a copy thereof by U.S. mail and email to:

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